UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,734	05/31/2000	Avner Shafrir	52817.000113	2781

29315 7590 01/03/2005		EXAMINER
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC		HAILU, TADESSE

ART UNIT	PAPER NUMBER
2173	

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DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 December 2004</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the AMENDMENT entered December 6, 2004

for the patent application number 09/583,734.

2.   The present patent application claims priority from domestic US Application

number 60/137,513 filed June 2, 1999.

3.   The pending claims 1-23 are examined as follows:

Claim Rejections - 35 U.S. C. § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

5.   Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mirabilis LTD, Quick Tour, February 12, 1998 in view of ICQ Inc, ICQ Email Signature,

May 2, 1999.

ICQ is an application that is used as a tool for communication. After installing this

software application in a computer, ICQ allows you to know who is online (network), and

allows you to contact other individuals just by clicking the individual's identifier, such as

by clicking individual's name or any graphical representation of the individual, such as

an icon displayed next to the individual. After clicking/selecting the individual's identifier,

an interested user can communicate by sending message to the individual, initiate a

chat session or launch any other interactive session (communication mode). ICQ

automatically detects user connection to the Internet and announces your presence

(on-line status indicator) to those whose list (contact list) you are on and notifies you if

your contacts are on-line (status indicator) as well. This status indicator is color-coded

symbol (flower icon), i.e., it changes to green to announce your presence to those

whose list you are on. Moreover, as described below, it is clear that the current claims

are not distinguishable over the cited art.

With regard to claim 1:

As per "status presenting means," as mentioned above, ICQ, as described and

illustrated in Quick Tour, discloses a status presentation means for presenting status

indicators associated with corresponding user indicators. ICQ also provides a real-time

status of the one or more target users (see Quick Tour, page 5);

as per "communication means," ICQ, as described and illustrated in Quick Tour,

discloses communication means for enabling ICQ users to exchange information with a

preferred or selected communication mode with a selected indicator (user indicator).

Using the Internet, ICQ users can communicate with each other by clicking the name

(identifier) or the icon next to it and then send a message, initiate a chat session

(real-time) or launch any other interactive session (communication mode) (see Quick

Tour, page 6);

as per "user indicator presentation means," ICQ, as described and illustrated in

Quick Tour, discloses a user indicator presentation means for presenting a user

indicator, such indicator includes among others, a name of a user, the user's numeric id

(ICQ#), or any form of identification. As mentioned above these indicators allow a user

to establish communication with other users on a network.

However, ICQ, as described and illustrated in Quick Tour, fails to explicitly

describe enabling any other application to generate and present the status indicator

within at least one electronic document, wherein the at least one electronic document is

generated using any of a plurality of applications. ICQ, in ICQ Email Signature, explicitly

describes enabling any other application to generate and present the status indicator

within at least one electronic document (ICQ Email Signature, page 2). ICQ enables

users to select any other applications, such as Netscape 3, Microsoft Outlook Express,

Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the

selected applications (ICQ Email Signature, page 2). Thus, Quick Tour & Email

Signature discloses "...two or more types of applications". That is, Quick Tour & Email

Signature discloses that each document is generated by its associated application, that

is, e-mail document is generated by e-mail application; chat document is generated by

chat application, HTML document is generated by HTML application, Telephonic

document is generated by telephonic application and audio-video document is

generated by audio-video application.

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of the invention was made to incorporate the user indicator (signature) feature

to the previous version of ICQ (How to Use ICQ) because it enhances the ICQ

communication tool and at the same time this enhancement will benefit the users of

both ICQ and non ICQ users as well.

With regard to claims 6, 10 and 15:

Since independent claims 6, 10 and 15 include relevant limitations similar to those found in claim 1, these claims are also rejected for at least the reasons disclosed above with respect to claim 1.

With regard to claim 21:

In addition to the above independent claims recited limitations, Claim 21 further calls for "a user indicator presentation module" associated with a first system application and a status determining module associated with a second system application, wherein, the first and second system applications are different system applications. ICQ (Quick Tour & Email Signature) teaches the above limitations, wherein status can be associated with e-mail, chat or conference application that determines a status of a user associated with the user indicator (Quick Tour, page 6).

With regard to claim 22:

In addition to the above independent claims recited limitations, claim 22 further calls for "a status determining module," ICQ (Quick Tour & Email Signature) provides plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on the Internet, wherein different applications (such as voice, data sharing application) could be associated with the status of the user (Quick Tour, page 5).

With regard to claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 17, 19 and 20:

ICQ (Quick Tour & Email Signature), as mentioned above, does provide several communication modules to a user including e-mail, chat, send and receive message

files and URLs, play games, draw on whiteboards, data conference, and communicate

through voice while surfing the net (Quick Tour, page 6). User can initiates or

establishes any one of the communication modes he/she prefers and share at least one

application with one or more users (Quick Tour, page 6).

With regard to claims 3, 8, 12 and 18:

ICQ (Quick Tour & Email Signature) automatically updates the user's status

(such as online) during connection to the network. After establishing connection, user

can also customizes, changes/updates his/her status (Quick Tour, page 5).

With regard to claim 23:

In addition to the limitations recited in the above Independent claims (e.g., claim

10), claim 23 further recites a user directory that includes user information that

corresponds to the plurality of target network users, wherein the user information

includes user indicators. Similarly, ICQ (Quick Tour & Email Signature) discloses a

contact list (a user directory) that includes user information that corresponds to the

plurality of target network users, wherein the user information includes user indicators

(see Quick Tour, pages 4-8). Claim 23 also recites documents generated by the two or

more types of applications, wherein each document includes at least two user

depictions associated with at least two target network users. Similarly, ICQ (Quick Tour

& Email Signature) discloses   e-mail document, chat document, web document, etc,

see Quick Tour), as per "each document includes at least two user depictions

associated with at least two network users," ICQ further describes each document

includes users indicator icons, (see Quick Tour, pages 4-8). Claim 23 further recites an

identification-determining module, which is similar to Quick Tour in view of Email

Signature name, ICQ number or contact list , see Quick Tour, pages 4-8.

Response to Arguments

6.   Applicant's arguments filed December 22, 2004 have been fully considered but

they are not persuasive.

The Applicant argues the cited references, both alone and inc combination, fail to

teach or suggest an identification determining module and a user indicator presentation

module. The Examiner disagrees because ICQ does disclose an identification-

determining module, such as name or ICQ number, etc. ICQ also discloses user

indicator presentation module, for example name or ICQ number can be presented

within a document (e.g., Email Signature's Email address of a user).

Applicant submit a copy of a portion of the homepage of the Wayback Machine

website. Applicant further states that the archive data is only represented by the

Wayback Machine as being accurate for the homepage, and not for other archived

pages linked thereto. The Examiner disagrees because each complete URL pages has

its own corresponding posting date. For example, one of the references cited ("How to

Use ICQ") has a complete URL name

http://web.archive.org/web/19980212181102/www.icq.com/icqtour/fulltour.html, wherein

the posting date is 2/12/98. Similarly, the ICQ Email Signature has its own complete

URL name, that is,

http://www.archive.org/web/19990502092623/9cq.com/emailsig.html, wherein the

posting date is 5/2/1999. While the Applicant does not argue the publishing date of

"How to Use ICQ", but the Applicant argues for the ICQ Email Signature publication

date. The examiner would like to indicate the Applicant by entering any one of the

above URL, one can only reach to a designated particular page not to a home page as

applicant suggested. Therefore, the publication date relied upon by the Examiner for

ICQ Email Signature is correct.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-

4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts

to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John

Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

8.   An inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(703) 305-3900.

Tadesse Hailu
December 22, 2004